RESPONSE AND REMARKS

The recent telephone interviews on April 7 and 8, 2004 with Examiner Cosimano are gratefully acknowledged with appreciation. A summary of the substance of those interviews is included in the substance of this Response and Remarks.

Amendments to independent Claims 1, 9, and 20 are filed concurrently herewith to more particularly claim the invention; independent Claims 6 and 7 have been amended above to correct punctuation; Claim 8 has been amended to depend on Claim 7; the amendments filed concurrently herewith also reflect renumbering of original Claims 20-31 as Claims 19-30 respectively; the amendments also reflect renumbering of dependencies of renumbered Claims 20-30 to reflect the respective renumbering of original Claims 20-31 as Claims 19-30. Dependent Claims 2-5, and 10-18 remain in the application unamended. Entry of the amendments and reconsideration of the application, as amended, are respectfully requested.

The Examiner organized the Office action by numbered topics. In this Response, responsive measures refer to the Office action topic numbers with the abbreviation OA Topic #.

In the Office action, the Examiner objected to the specification on multiple grounds. To resolve the objections, a substitute specification is submitted herewith in accordance with 37 C.F.R. §1.125. In compliance with 37 C.F.R. §1.125 (b)(1), applicant states that the substitute specification contains no new matter. As required by 37 C.F.R. §1.125 (b)(2), a marked up version of the substitute specification showing all the changes to the specification of record is filed herewith, and as required by 37 C.F.R. §1.125 (c), a clean version of the substitute specification is also filed herewith.

CLAIM RENUMBERING

In the Office action, the Examiner objected to the numbering of the Claims (OA Topic 2), noting that no Claim 19 was originally presented. The Examiner renumbered Claims 20-31 as Claims 19-30 respectively. The renumbering of claims is reflected in the amendments submitted herewith.

TRADEMARKS

In the Office action, the Examiner objected to use of various trademarks as used in the specification (OA Topic 3) and indicated that the trademarks should be capitalized wherever they appear. Responsive to the Examiner's objections to the use of trademarks, the substitute specification identifies trademarks used in the specification, references the proprietary nature of those trademarks through the use of the "TM" symbol, and equates the TM-designated trademark with both an all-capitalized version of the trademark and with alternative ways in which the trademarks appear in the specification.

DRAWING LABELING

In the Office action, the Examiner objected to the labeling of drawings that used non-capital letters to designate sub-parts (OA Topic 4), and indicated that redlined drawings indicating proposed drawing corrections would need to be filed; formal drawings could be deferred until after consideration of the proposed drawing corrections. The Examiner objected to corresponding specification references to the non-capital letter labeling (OA Topic 5.B)). Responsive to the Examiner's objections to the labeling of the drawings, redlined drawings indicating the proposed re-labeling using capital letters are filed herewith; the substitute specification reflects the re-labeling using capital letters.

SPECIFICATION AND DRAWINGS

In the Office action, the Examiner further objected to the drawings, or in some cases, to the specification, because of reference numbers contained in the drawings, but which were not identified in the specification, or vice versa (OA Topics 4.A)(10), 4.A)(11), 5.A). With the few exceptions explained below, the substitute specification or the redlined drawings respond to the Examiner's objections.

In OA Topic 4.A)(11), the Examiner objected to FIG. 36A because the specification mentioned the number 1071 whereas the drawings do not show an element 1071 unqualified with suffixes. It is respectfully submitted that the specification reference to the number 1071 is a reference to drawing elements 1071-1-1 through 1071-6-7; it is further respectfully submitted that drawing elements 1071-1-1 through 1071-6-7 are properly referenced because the

specification explains that "cells" of the Graphic Array are referenced by the number 1071 in combination with the intersecting row number (1 through 6) and column number (1 through 7). See Specification, page 46, lines 1-4. For example, cell 1071-1-1 references the cell of the Graphic Array in the first row (1) and the first column.

In OA Topic 5.A)(1)(a), the Examiner objected to the specification regarding certain element reference numbers with alphabetic suffixes appearing in FIG. 7. It is respectfully submitted that the specification properly references the alphabetic-suffixed element numbers in FIG. 7 in that, as explained in the specification on page 14, beginning at line 27 and continuing through page 15, line 1, that "suffixes such as "a" through "n" in connection with numbered elements of the FIGURES herein are exemplary and are not a limitation of the invention to any particular number. Rather, the suffixes "a" through "n" and "a" through "z", and similar notations, are used to represent any, but unknown, number of similar elements." Further, the numeric component of the objected to element numbers (9 of objected to element 9n, 11 of objected to element 11n, 12 of objected to element 12n, 13 of objected to element 13n, 21 of objected to element 21a, 1003 of objected to elements 1003a – 1003d, 1024 of objected to element 1024n, and 1027 of objected to element 1027n) are discussed with reference to FIGS. 3 and 4, beginning on page 15, line 16, through page 16, line 12.

In OA Topic 5.A)(1)(c), the Examiner objected to the specification regarding element 42 of FIG. 10A. It is respectfully submitted that element 42 of FIG. 10A is properly references at page 23, line 5 of the specification.

In OA Topic 5.A)(1)(af)(b), the Examiner objected to the specification regarding element 3026 of FIG. 36C. It is respectfully submitted that the specification mentions element 3026 at lines 5 and 8, page 56.

In OA Topic 5.A)(1)(af)(d), the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1163, 1168, 1169, 1172, and 1175 of FIG. 39B. It is respectfully submitted that the referenced "No" paths are implied in the specification as follows: the 1163 "No" path is implied on page 61, line 10; the 1168 "No" path is implied on page 61, line

19; the 1169 "No" path is implied on page 61, line 27; the 1172 "No" path is implied on page 62, line 9; and the 1175 "No" path is implied on page 62, line 19.

In OA Topic 5.A)(1)(af)(e), the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1180, 1184, 1187, and 1190 of FIG. 39C. It is respectfully submitted that the referenced "No" paths are implied in the specification as follows: the 1180 "No" path is implied on page 62, line 28; the 1184 "No" path is implied on page 63, line 10; the 1187 "No" path is implied on page 63, line 20; and the 1190 "No" path is implied on page 64, line 1.

In OA Topic 5.A)(1)(af)(f), the Examiner objected to the specification regarding the "Yes" and "No" logic paths for inquiry element 1192. It is respectfully submitted that the "No" logic path is described in lines 3-4 page 63 of the specification, and is further implied by virtue of the mention in the specification of element 1177 in line 5, page 63; the "Yes" logic path is described in lines 26, page 63 through line 2, page 64 of the specification and is further implied by virtue of the mention in the specification of element 1193 in line 1, page 64.

In OA Topic 5.B)(11), the Examiner objected to the specification regarding reference to an Account User Configuration table 253 in FIGS. 33A-33B. It is respectfully submitted that the specification properly references the table in FIG. 33B labeled ACCOUNTUSERCONFIG 253 as Account User Configuration table 253 is proper because ACCOUNT USER CONFIG is merely an abbreviation for Account User Configuration.

In OA Topic 5.B)(12), the Examiner objected to the specification on grounds that the specification description of inquiry 3026 at lines 3-5 of page 56 appeared inconsistent with the specification description of inquiry 3026 at lines 7-9 of page 56. It is respectfully submitted that the specification description of inquiry 3026 at lines 3-5 of page 56 that describes the 3026 test as whether a particular carrier *supports* the given billing option based on step 2 is consistent with, and is merely a different way of describing inquiry 3026 as described by, the specification description of inquiry 3026 at lines 7-9 of page 56 that describes the 3026 test as whether a particular package weight and dimensions *violate* carrier

business rules.

SECTION 112

In OA Topic 7, the Examiner rejected Claims 8 and 19 (originally, Claim 20, renumbered as Claim 19) as begin indefinite under 35 U.S.C. §112.

Claim 8 has been amended to depend on Claim 7, as opposed to Claim 2; it is respectfully submitted that Claim 8 as amended meets the Section 112 standard for definiteness.

Amendments submitted herewith reflect original Claim 20 renumbered as Claim 19 and renumbered Claim 19 dependency on Claim 18; it is respectfully submitted that Claim 19 as amended meets the Section 112 standard for definiteness. The amendments submitted herewith also reflect renumbering of the dependencies of Claims 20 through 30 (renumbered) to reflect the renumbering of original Claims 21 through 31 as Claims 20 through 30.

TERMINAL DISCLAIMERS

In OA Topic 8, the Examiner provisionally rejected Claims 1-30 under the judicially created doctrine of double patenting over the claims of Application Nos.: 09/680,649, 09/680,654, 09/684,014, 09/684,861, 09/684,865, 09/684,866, 09/684,869, 09/685,077, and 09/685,078.

The present application and all patents that may issue from it have been assigned to Stamps.com Inc. and to iShip Inc., both of which own all right title and interest in the application and patents issuing from it in an undivided whole interest in common. Terminal Disclaimers, one executed by Stamps.com Inc., and the other executed by iShip Inc., to Obviate a Provisional Double Patenting Rejection Over Pending Second Applications as identified in OA Topic 8, are submitted concurrently herewith under 37 CFR 1.321.

SECTION 102

In OA Topic 9.2 of the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by a PR Newswire release by WorldWide Merchant regarding InterShipper 4.0. In the Office Action, the Examiner referred to this reference as "TEMPE"; it is referred to herein as "*InterShipper*"). In OA Topic 9.2 of the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by Barton, U.S.

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Patent Application Publ'n No. US 2002/0022983 (Serial No. 09/873,756)
("_Barton_").

In OA Topic 9.1 of the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. § 102(b) as being anticipated by a PR Newswire release by TanData, reflecting a date of July 21, 1997. In the Office Action, the Examiner referred to this reference as "TULSA"; it is referred to herein as "_TanData_"). In OA Topic 9.1 of the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. § 102(b) as being anticipated by Thiel, U.S. Patent No. 5,699,258 ("_Thiel_").

The Examiner's rejection of the Claims has been carefully considered.

Submitted herewith are claim amendments to independent Claims 1, 9, and 20 to more particularly claim the invention. It is respectfully submitted that the Claims, as amended, are patentably distinct from the cited references. Reconsideration of the application, as amended, is respectfully requested.

1.   **_Section 102(e)_**

    a.   **_InterShipper_**

According to the _InterShipper_ reference, the publication date of that reference was March 23, 1999.

Filed concurrently herewith is a Declaration by the inventors named on the present application under Section 131 swearing behind the publication date of that reference for all claims of the present invention.

    b.   **_Barton_**

According to the _Barton_ reference, the filing date of _Barton_ was June 4, 2001;_Barton_ was a CIP of an application (No. 09/557,822) that had a filing date of April 25, 2000, which was a CIP of an application (No. 09/303,788) that had a filing date of April 30, 1999.

Filed concurrently herewith is a Declaration under Section 131 swearing behind a date which precedes the earliest priority date, namely April 30, 1999, in the _Barton_ CIP-of-a-CIP chain for all claims of the present invention.

2.   **_Section 102(b)_**

    a.   **_TanData_**

It is respectfully submitted that the Claims, as amended, are patentably distinct from the *TanData* reference in that the Claims of the present application, as amended, are directed to parcel shipping management computer systems comprising, methods wherein, and computer program products for, a plurality of server computer devices that are remotely accessible to a plurality of shipping users via a global communications network, such as the Internet.

As compared to the system remotely accessible by a plurality of shipping users as presently claimed, it is respectfully submitted that the *TanData* reference discloses, as explained in more detail below, a system that was specifically programmed to handle a particular shipping user's shipping circumstances (e.g., from location); each user-tailored *TanData* system application was accessible by, and for the benefit of, that particular shipping user.

The cited *TanData* news release announces the release of a product called "Progistics.Merchant." However, the *TanData* news release does not disclose how TanData's "Progistics.Merchant" system operated in relation to each user of a plurality of users, and more specifically, how TanData's "Progistics.Merchant" system provided shipping functionality rules for a particular user of a plurality of users. Moreover, there is no disclosure in the *TanData* news release that a single installation of the *TanData* system was capable of processing shipping information by more than one shipper or was accessible via the Internet by a plurality of shippers.

Even though the *TanData* news release does not itself disclose how TanData's "Progistics.Merchant" system operated, the *TanData* reference does explain that its shipping and rating functionality is provided using "TanData's patented RateServer ™ client/server technology." *TanData.* ¶ 1. It is respectfully submitted that the referenced patents are instructive in examining the present application as compared to the *TanData* reference.

According to the U.S. Patent Office website (www.uspto.gov), there are two patents assigned to a company named TanData Corporation, of Tulsa Oklahoma. One is Nicholls, U.S. Patent No. 5,485,369 ("*Nicholls I*"), issued January 16, 1996; the other is Nicholls, U.S. Patent No. 5,631,827 ("*Nicholls II*") issued May 20, 1997. According to *Nicholls II*, that patent issued from a

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divisional of the application that issued as _Nicholls I_. Because _Nicholls II_ is a divisional of _Nicholls I_, references below to _Nicholls I_ apply for the most part (with the exception of references to _Nicholls I_ claims) to _Nicholls I_.

It is respectfully submitted that the _TanData_ "Progistics.Merchant" system had to be specifically programmed to handle a particular shipping user's shipping circumstances (e.g., from location). _See Nicholls I_ at Col. 1, lines 59-61 (". . . facilitates the process of shipping goods by a shipper having a predefined set of shipping requirements via a carrier having a predefined rate structure."); _Nicholls I_ at Col. 2, lines 31-34 ("The client process has a preprogrammed set of rules which are reflective of a given shipper's predefined set of shipping requirements.").

Each user-tailored _TanData_ "Progistics.Merchant" system application was to be implemented on a computer/computer system to be accessible by, and for the benefit of, that respective particular shipping user. _See, e.g., Nicholls I_ at Col. 4, lines 55-60 ("The presently preferred embodiment facilitates the particular Shipper's requirements . . . in one or more client applications. These client applications may be customized to conform quite closely to a given shipper's operation."); _Nicholls I_ at Col. 10, lines 51-52 ("This allows the user to load in new rate information as soon as such information is provided by the carriers."); _Nicholls I_, Claim 1 ("said client process further having preprogrammed set of rules reflective of said shipper's predefined set of shipping requirements . . . . .").

As compared to the _TanData/Nicholls I_ references, the claims of the present application are directed to a parcel shipping management computer system comprising a plurality of server computer devices that are remotely accessible to a plurality of shipping users via a global communications network, such as the Internet.

Independent Claims 1, 9, and 20 have been amended to more particularly claim the remote accessibility ("via a global communications network") by a plurality of shipping users. Similarly, Claims 6 and 7 are directed to remote ("over a global communications network") accessibility by a plurality of shipping users.

As disclosed in the present application, each shipper (3a-3n of FIG. 2) views the claimed system (1 of FIG. 2)) as an individualized automated Shipping System. _Specification_, p.15, lines 4-5. However, even though each shipper has such an individualized view of the system of the claimed invention, the claimed invention provides a centralized server-based system that is remotely accessible over, _e.g._, the Internet, to all of its shipping users. See, _e.g._, _Specification_, p. 15, lines 2-26.

As disclosed in the present application; each shipper can independently register with the system of the claimed invention and designate, via user input, information particular to that respective shipper, such as the shipper's address and ship-from location. See, _e.g._, _Specification_, pp. 23-24. Each shipper can then ship parcels using the system of the claimed invention to any recipient. See, _e.g._, _Specification_, p. 15, lines 2-11. That is, the system of the claimed invention provides remote shipping functionality to ship parcels from any shipper/anywhere to any recipient/anywhere.

As compared to the from-any-shipper/anywhere to-any-recipient/anywhere capability of the claimed invention of the present application, the _TanData_ reference, even when made available over the Internet (_TanData_, pg. 1, ¶4), only discloses a system in which ". . . a preprogrammed set of rules which are reflective of a given shipper's predefined set of shipping requirements." _Nicholls_ I at Col. 2, lines 31-34.

It is respectfully submitted that disclosure of a system in which ". . . a preprogrammed set of rules which are reflective of a given shipper's predefined set of shipping requirements. . . ." (_Nicholls_ I at Col. 2, lines 31-34) does not disclose or anticipate a shipping management computer system in a multi-user environment as recited in the rejected claims wherein the system is remotely accessible by a plurality of shipping users over a global communications network (such as the Internet).

b.　**_Thiel_**

It is respectfully submitted that the Claims, as amended, are patentably distinct from _Thiel_, in that the Claims of the present application, as amended, are directed to parcel shipping management computer systems comprising, methods

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wherein, and computer program products for, a plurality of server computer devices that are remotely accessible to a plurality of shipping users via a global communications network, such as the Internet.

Although *Thiel* does mention a communications network (*Thiel*, col. 3, lines 9-20), the communications network mentioned in *Thiel* is merely a transmission means for downloading postage rate tables into memory of a postal franking device. *See, e.g., Thiel*, col. 2, lines 56-65.

Further, it is respectfully submitted that any particular *Thiel* postal franking device is only locally available to a particular shipping user. *See, e.g., Thiel*, col. 8, line 39 – col. 9, line 10; see also, e.g., *Thiel*, col. 9, lines 1-10. A *Thiel* postal franking device rates a shipment based on postage rate tables that have been downloaded and stored in the memory of that particular device. *See, e.g., Thiel*, col. 8, line 39 – col. 9, line 10. In *Thiel*, the weight and type of mail is input by a single user using an input means to the particular postal franking device. *See, e.g., Thiel*, col. 9, lines 1-10.

As compared to the locally accessible postal franking device of *Thiel* for use by a single particular shipping user, the system of the claimed invention is a centralized server-based system that is remotely viewed by each of a plurality of shippers (3a-3n of FIG. 2) over a global communications network, such as the Internet, as an individualized automated Shipping System. *Specification*, p.15, lines 2-26. As compared to *Thiel*, the shipping management system of the claimed invention is available for remote access by a plurality of users over a global communications network. As opposed to merely downloading rate tables using a network from some computer to one of the *Thiel* franking devices, the server-based system of the claimed invention is remotely accessible by many users via a global communications network, such as the Internet, and is capable of providing shipping management functionality to all of the system's many users.

It is respectfully submitted that disclosure of a device, such as the *Thiel* postal franking device, that is only locally accessible to a particular shipping user does not disclose or anticipate a shipping management computer system in a multi-user environment as recited in the rejected claims wherein the system is

remotely accessible by a plurality of shipping users over a global
communications network (such as the Internet).

CONCLUSION

For all of the foregoing reasons, it is therefore respectfully submitted that
independent Claims 1, 6, 7, 9, and 20 of the present application, as amended,
are patentable over the cited references.

Further, because for all of the foregoing reasons, independent Claims 1, 6,
7, 9, and 20 of the present application, as amended, are patentable over the
cited references, it is respectfully submitted that dependent Claims 2-5, 8, 10-19,
and 21-30 are therefore also patentable over the cited references.

In view of the foregoing amendments, Applicant respectfully submits
that the invention disclosed and claimed in the present application as amended is
not fairly taught by any of the references of record, taken either alone or in
combination and that the application is in condition for allowance. Accordingly,
Applicant respectfully requests reconsideration and allowance of the application
as reflected in the substitute specification and as amended herewith concurrently
filed herewith.

Respectfully submitted,

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